

claims 6-9, 14, 15, 17, 24-26 and 30 as obvious under 35 U.S.C. § 103(a) based on *Taskett* in view of *Cho* and in further view of *Gow* (US 5,828,732).

With respect to the independent claims 1, 10, 16, 19, 27 and 31, the Office Action now applies the new reference of *Cho* for a supposed disclosure of the claimed "personal greeting" in acknowledgement that *Taskett* fails to disclose such a feature. Once again the Office Action has engaged in impermissible hindsight reconstruction of Applicant's claimed invention; this time, the Office Action has additionally delved into employing non-analogous art to contrive a structure to satisfy the features of the claims.

*Cho* is directed to a facsimile system with a telephone handset linked to a personal computer (see FIG. 1; col. 3, lines 43-57). *Cho* discloses, on col. 4, lines 28-34, that the PC 138 is connected to the CPU 110 through the connector 136 which allows the CPU 110 to control recording of the user's voice message for greeting the caller in the event the user does not want or is unable to answer an incoming call, and to control recording of the caller's voice message in an auxiliary memory such as a hard disk of the PC 138. Additionally, per the cited passage of col. 5, lines 8-12, *Cho* describes that a voice message recording mode is initiated when the user wants to record a personal voice message greeting the caller in the event the user does not want or is unable to answer the incoming call. The control sequence begins with determining whether the telephone 126 is in an off-hook condition at step 200, that is when the user picks up the telephone handset 126 in a recording mode.

The *Cho* facsimile system is designed to address the problem of the limited storage capacity and functionality of a conventional facsimile system. For example, *Cho*, on col. 2, line 41-53, discusses that in the conventional facsimile system having an automatic telephone answering function, the capacity of a voice storage medium into which incoming voice message is recorded is relatively small, and there is a time limit relating to the automatic telephone

answering function. For instance, if the user of the telephone handset as incorporated in the facsimile system is absent for a long time period, there is no way to modify the user's voice message to be sent to several different people. Moreover, in case where the callers leave many voice messages, and the voice storage medium is full with voice messages, a new voice message cannot be recorded on the storage medium and is therefore lost at the time when voice communication is established.

Applicant submits that *Cho* is non-analogous art, in contravention of MPEP §2141.01(a). Pursuant to MPEP §2141.01(a), the Examiner must determine what is "analogous prior art" for the purpose of analyzing obviousness. In order to rely on a reference as a basis for rejection of an Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In the case at hand, one skilled in the art would not consult *Cho* to address the problem of allowing providers of pre-paid cards to offer enhanced services. Further, the *Cho* design concerns problems on the CPE (customer premises equipment) side, while the present invention involves network services. The identified problem of voice storage in a CPE facsimile system has no bearing on the problem solved by the claimed invention.

Furthermore, pursuant to MPEP § 2143.02, the Examiner must consider whether the modified system would have a reasonable expectation of success to meet his burden of showing *prima facie* obviousness. In the case at hand, the Office Action simply engages, with no technical foundation, in modifying the *Taskett's* distributed system, which supports a prepaid

instrument for providing access to a service provider network, based on the disclosure of *Cho*, which concentrates on supporting enhanced voice storage capability on a facsimile system. As noted above, the *Cho* facsimile system concerns equipment on the user end, external to any network, and cannot possibly teach how to effect such enhancements on the network side. One skilled in the art would appreciate the disparity of the *Taskett* and the *Cho* systems, and question the success of the proposed modifications.

Even assuming that the references of *Taskett* and the *Cho* were properly combined based on some teaching or suggestion in the references, and assuming the modifications proposed in the Office Action were justified by additional teachings or suggestions found in the references, even the combination does not render the claimed invention obvious. Specifically, none the references taken alone, or in combination, teaches or suggests “a request to record said personal greeting **during a setup call** over a telephone network.” To satisfy this feature, the Office Action refers to the “an off-hook condition” in the *Cho* system (col. 5, lines 12-13). From the network perspective, the call in the *Cho* system is already setup with the facsimile system, the off-hook condition is referring to the state of the telephone handset 126. This sequence is necessary for the facsimile system to operate (that is, to receive faxes); the intervention by the user by going off-hook is to trigger the recording mode (col. 5, lines 4-31). Therefore, the request to record cannot be made **during a setup call**. This impossibility further underscores that the *Cho* system is strictly a customer premises function, and not a network service.

The several secondary references of *Khuc et al.*, *Bruno et al.*, *Nguyen et al.*, and *Gow* do not fill in the gaps of the *Taskett* and *Cho* combination, particularly with respect to the feature of “a request to record said personal greeting **during a setup call** over a telephone network.”

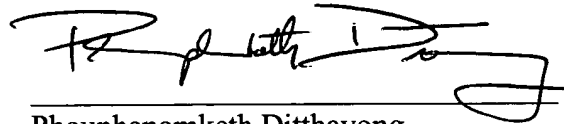
Based on the above arguments, Applicants respectfully request the withdrawal of all the obviousness rejections, and urge the indication that all pending claims 1-33 are allowable.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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